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No. 86-891

Supreme Court, U.S.
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In the
Supreme Court of the United States
October Term, 1986

MEAD DATA CENTRAL, PETITIONER,

vs.

WEST PUBLISHING COMPANY, RESPONDENT.

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ON PETITION FOR A WRIT OF CERTIORARI TO THE
UNITED STATES COURT OF APPEALS
FOR THE EIGHTH CIRCUIT

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BRIEF IN OPPOSITION

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VANCE K. OPPERMAN
Counsel of Record
JOSEPH R. KERNAN, JR.
DIANE M. HELLAND
Counsel for Respondent

OPPERMAN & PAQUIN
2200 Washington Square
100 Washington Avenue South
Minneapolis, Minnesota 55401
(612) 339-6900

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Questions Presented for Review

Petitioner's star pagination will supplant the need for respondent's copyrighted case report compilations which are protected by §§ 103 and 106 of the Copyright Revision Act of 1976. Respondent sought preliminary and permanent relief from petitioner's unauthorized commercial use of respondent's arrangements of case reports in its copyrighted works. The court of appeals affirmed the district court's grant of a preliminary injunction.

The questions presented are:

1. Whether it was error to issue a preliminary injunction restraining petitioner from reproducing and displaying on LEXIS the arrangements from respondent's copyrighted case report compilations.
2. Whether respondent's arrangements within its case report compilations satisfy the standard of originality under copyright law.
3. Whether petitioner's "star pagination" in its computerized database is an infringing use of respondent's copyrighted works.

Statement Pursuant to Rule 28.1

Respondent West Publishing Company is a privately held corporation organized under the laws of the State of Minnesota. It has no parent company or affiliates. The Foundation Press, Inc. is a subsidiary of West Publishing Company which is not wholly owned.

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ON PETITION FOR A WRIT OF CERTIORARI TO THE
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BRIEF IN OPPOSITION

West Publishing Company ("West") opposes the petition for a writ of certiorari to review the judgment of the United States Court of Appeals for the Eighth Circuit on an interlocutory appeal entered in this action on September 4, 1986.

STATEMENT OF THE CASE

West commenced this action to restrain Mead Data Central, Inc. ("MDC"), both preliminarily and permanently, from copying the arrangements of case reports from West's copyrighted compilations. MDC, a major competitor, designed its star pagination to reproduce West's arrangements of case reports for MDC's LEXIS subscribers and to supplant West's copyrighted works. MDC's star pagination does not consist of copying only West's "page numbers." MDC intends to reproduce West's volume

numbers; Reporter names; the points within the text of each case report at which West begins each page of text ("page breaks"); and the numbers used to reflect each page of text. MDC intends to unite these elements with the full text of the court opinions displayed on LEXIS, thereby electronically reproducing the arrangements from West's copyrighted Reporter volumes.

The district court granted preliminary relief. On appeal, the court of appeals examined the factors it balances on a motion for a preliminary injunction and affirmed the district court's order. The court of appeals' finding that there was a substantial likelihood that West would prevail on its copyright infringement claim at trial is in accordance with the Copyright Revision Act of 1976 ("1976 Copyright Act"), 17 U.S.C. § 101 *et seq.*, and applicable decisions of this Court. *Harper & Row, Publishers, Inc. v. Nation Enterprises*, 105 S.Ct. 2218 (1985); *Sony Corp. of America v. Universal City Studios, Inc.*, 464 U.S. 417 (1984); *Callaghan v. Meyers*, 128 U.S. 617 (1888).

A. Procedural History

On July 26, 1985 West filed an eleven-count Complaint against MDC in the United States District Court, District of Minnesota, alleging causes of action under the 1976 Copyright Act, 17 U.S.C. § 101 *et seq.*; Section 43(a) of the Lanham Act, 15 U.S.C. § 1125(a); the Minnesota Deceptive Trade Practices Act, *Minn. Stat.* § 325D.44; the Minnesota Unlawful Trade Practices Act, *Minn. Stat.* § 325D.13; and the common law of misappropriation and unfair competition. The Complaint sought relief from MDC's announced plan to reproduce in its LEXIS database, and to display to its LEXIS subscribers, West's arrangements of case reports from its copyrighted compilations through MDC's star pagination.¹ On August 27, 1985, West moved for a preliminary injunction

¹ West did not seek to prohibit MDC from using West's Reporter names, volume numbers and the initial page numbers, i.e., the numbers of the pages on which case reports begin. West believes the use of these aspects of its arrangements, without more, constitutes "fair use" since this use does not supplant the need for the copyrighted works.

restraining MDC from further reproduction and display of West's arrangements until a final determination on the merits of West's claims could be reached.²

The District Court (Honorable James M. Rosenbaum) issued the preliminary injunction on October 7, 1985. MDC filed an interlocutory appeal on November 1, 1985. The Eighth Circuit Court of Appeals affirmed, holding that there was a substantial likelihood that West's arrangements within its copyrighted compilations met the standard of originality required by copyright law and that MDC's star pagination infringed West's copyrights. 799 F.2d 1219, 1228 [Pet. App. A at A17].

Three aspects of the court of appeals' decision require emphasis:

1. The Eighth Circuit Court of Appeals balances four factors³ in determining whether a preliminary injunction should issue. No one factor — including likelihood of success on the merits — by itself is determinative.⁴ However, in the instant case the court of appeals, like the district court, found that on the factual record before it, *all four* factors weighed in favor of the preliminary injunction. 799 F.2d at 1229 [Pet. App. A at A19].

2. The court of appeals rejected MDC's claim that the district court's order is in conflict with the decision of the Second Circuit Court of Appeals in *Banks Law Publishing Co. v. Lawyers Co-Operative Publishing Co.*, 169 F. 386 (C.C.S.D.N.Y. 1909), *aff'd per curiam*, 169 F. 391 (C.C. 2d Cir. 1909), *appeal dismissed per stipulation*, 223 U.S. 738

² West's preliminary injunction motion was limited to the copyright infringement claim (Count I) of the Complaint.

³ The factors that the court of appeals examines are: (1) the probability that the movant will succeed on the merits; (2) the threat of irreparable harm to the movant should a preliminary injunction be denied; (3) the balance between this harm and the harm that granting the injunction will cause to the opposing party; and (4) the public interest. *Dataphase Systems, Inc. v. C L Systems, Inc.*, 640 F.2d 109, 113 (8th Cir. 1981) (en banc).

⁴ Notably, MDC does not seek review of the factors employed by the court of appeals for a preliminary injunction. Rather, MDC requests this Court to determine whether its star pagination infringes West's copyrights based on an incomplete factual record.

(1911). The court of appeals below determined that the *Banks* finding that the work was not copyrightable "was based upon the *official status* of the reporter," 799 F.2d at 1225 [Pet. App. A at A9-A10] (emphasis added), and thus factually distinguishable. The court of appeals further held that changes in both statutory and decisional copyright law since 1909 rendered the *Banks* case inapplicable to this action. 799 F.2d at 1226 [Pet. App. A at A11-A12].

3. The court of appeals explicitly and repeatedly qualified its conclusions pending further factual development at trial. "[O]ur observations as to the governing law made in this opinion, are tentative and provisional, in the sense that different findings or conclusions might be warranted after a trial on the merits." 799 F.2d at 1229 [Pet. App. A at A19] (citations omitted). Although no trial on the merits has yet occurred,⁵ MDC served West with the petition for certiorari on December 4, 1986.

B. Factual Background

West collects, compiles and publishes opinions of state and federal courts from throughout the nation in several series of volumes it calls National Reporter System publications. Before it publishes an opinion, West checks the accuracy of case and statutory citations in the opinion and adds parallel citations, prepares headnotes and a synopsis for the opinion, and arranges the text of the opinion in West's style and format. West then assigns its report of each opinion to one of the individual series in the National Reporter System, such as *Federal Reporter*, *Second Series* or *Southern Reporter*, *Second Series*; this assignment is based on the court and/or the subject matter of the opinion. Next, West assigns the case report to a volume in the series and further categorizes and arranges the case reports within each volume. For example, West

⁵ The parties stipulated to an order on September 25-26, 1985 staying all discovery during the course of any appeal from the district court's decision. Order of September 27, 1985. As a result, discovery has only recommenced in the last 90 days and is in the initial stages.

currently arranges the decisions it publishes in *Federal Reporter, Second Series* advance sheets by grouping all opinions from each circuit court of appeals together; then, within each grouping it arranges all opinions with West-supplied headnotes first, then memorandum decisions without headnotes, and finally listings of decisions rendered without published opinions. For each separate volume, West then prepares additional materials, such as indices and tables of cases. Volumes and pages are numbered sequentially to facilitate precise reference to West's case reports; citing the proper volume number, Reporter name and page number communicates the exact location of a West report, or a portion thereof, within the National Reporter System. Upon publication of each volume, West registers its copyright claim with the Register of Copyrights and receives a Certificate of Registration for the volume.

Although MDC currently displays on LEXIS the West citations (*i.e.*, volume numbers, Reporter names and page numbers on which case reports begin),⁶ it does not employ any arrangement of its own which is useful for citation purposes.⁷ On June 24, 1985 MDC announced that by the end of September, 1985 it would add star pagination to the text of federal judicial opinions stored in the LEXIS database. (Answer ¶¶ 15 and 16). MDC admits this would consist of copying each and every page break and page number from West's reports in *Federal Reporter*, *Federal Reporter, Second Series*, *Federal Supplement*, *Federal Rules Decisions* and *United States Claims Court Reporter* and incorporating these page breaks and page numbers within the text of LEXIS reports. (Answer

⁶ MDC's star pagination is unlike mere citation to West case reports in several important respects: (1) MDC's star pagination encompasses the total of *all* page numbers of West's Reporter volumes; citation involves far less than the total; (2) star pagination, unlike citation, marks the page *break* for each and every page of text; (3) star pagination, unlike citation, is used in conjunction with the entire text of court opinions; and (4) most importantly, star pagination supplants the need for West's Reporters.

⁷ Obviously, MDC could easily do so. For example, it could number the paragraphs or the screens of its case reports; either would provide its subscribers with a detailed citation method.

¶¶ 15 and 16). As a result of this copying, MDC will be able to display and print for its subscribers West's sequencing of case reports. It is MDC's stated belief that doing so will increase "the number of LEXIS users, the use of LEXIS and the revenues MDC derives therefrom." (Answer ¶¶ 18 and 62). MDC also admits that incorporating West's page breaks and pagination within the text of LEXIS reports will in some instances completely replace the use of West's Reporters. (Transcript of Hearing on September 17, 1985 at pp. 72-73.)

ARGUMENT

A writ of certiorari is unwarranted. The court of appeals' decision merely affirms an interlocutory order for a preliminary injunction based upon tentative conclusions of law subject to modification upon further factual findings. Moreover, the court of appeals' application of law to the specific and unusual facts presented is entirely consistent with the language of the statutory provisions at issue and established precedents of this Court. Even after a full trial, this Court does not issue a writ of "certiorari to review evidence and discuss specific facts." *United States v. Johnston*, 268 U.S. 220, 227 (1925); *Texas v. Mead*, 465 U.S. 1041 (1984). In any event, there is no conflict between the decisions below and any decision of this Court or any other court of appeals.

I. The Court Of Appeals' Decision Does Not Create A Conflict In The Circuits.

Key factual differences and congressional revisions of the Copyright Act distinguish the court of appeals' decision at issue from the Second Circuit Court of Appeals' decision in *Bank's Law Publishing Co.*, *supra*. The court of appeals below held that there was a substantial likelihood that West's arrangements within its compilations of case reports are original; the court thus concluded they are protected by the 1976 Copyright Act. 799 F.2d at 1227 [Pet. App. A at A14]. This conclusion followed from a critical

factual finding — a finding of originality — which is fact specific and unique to each copyright claim.

The plaintiff in *Banks*, on the other hand, failed to establish that his arrangements of case reports were original. The *Banks* court held that the plaintiff, as an *official reporter*, had not exercised sufficient originality in his arrangements of case reports, beyond his statutory obligations, to obtain copyright protection. 169 F. at 389-390. Unlike the arrangement of case reports at issue in *Banks*, West's arrangements within its National Reporter System publications are not dictated by contract or statute.⁸ They are original to West. The different outcomes in *Banks* and this case are thus a result of the different sets of *facts* presented to the courts; no conflict of law exists.

In addition, major revisions of the Copyright Act in 1909 and 1976 explicitly enlarged the scope of copyright protection. Significantly, the statute in effect at the time of the *Banks* decision did not expressly provide copyright protection for either compilations or arrangements. Act of March 3, 1905 Ch. 1432, Pub. L. No. 58-165, 33 Stat. 1000 (1905) (repealed 1909). Four months after the *Banks* decision, Congress codified copyright protection for compilations. 17 U.S.C. § 7 (1909) [effective July 1, 1909]. The most recent comprehensive revision of statutory copyright law occurred in 1976. In the 1976 revisions, Congress specifically declared copyrightable an author's original efforts in selecting, coordinating and arranging preexisting materials.⁹ The *Banks* court interpreted and applied a statute repealed in 1909. The court of appeals below interpreted and applied the provisions of a *different* statute — a statute enacted in 1976.

⁸ Of course, there is no evidence that West is, or ever was, the official reporter for the federal courts. The evidence presented below reveals only *one* instance, in 1894, where West indicated that it was the official reporter for the federal courts.

⁹ The 1976 Copyright Act defines a compilation as:

A work formed by the collection and assembling of preexisting materials or of data that are selected, coordinated, or arranged in such a way that the resulting work as a whole constitutes an original work of authorship.

17 U.S.C. § 101.

Because of the critical factual differences in this case and congressional changes in copyright law, the 1909 *Banks* decision is not controlling in the resolution of the issues presented by West's motion for a preliminary injunction. No conflict was, or could be, created by the court of appeals' decision under current law.

II. The Court Of Appeals' Decision Is Consistent With The Applicable Statute And Precedents Of This Court.

The court of appeals held that, under the 1976 Copyright Act, West's original case report compilations are copyrightable. 799 F.2d at 1223-1224 [Pet. App. A at A6-A7]. The court below further held that MDC's star pagination would infringe West's copyrights.¹⁰ 799 F.2d at 1228 [Pet. App. A at A17]. The 1976 Copyright Act and precedents of this Court support the court of appeals' conclusions.

A. Copyright Law Protects West's Arrangements of Case Reports.

The copyright statute provides protection for compilations. 17 U.S.C. § 103. The 1976 Copyright Act definition of a compilation explicitly recognizes an author's efforts in selecting, coordinating and arranging preexisting materials. 17 U.S.C. § 101. Original compilations of case reports are no exception. This Court long ago noted:

Such work of the reporter, which may be the lawful subject of copyright, comprehends also the order of arrangement of the cases, the division of the reports into volumes, the numbering and paging of the volumes. . . .

Callaghan, supra, 128 U.S. at 649. Rather than departing from traditional standards, the court of appeals' decision is

¹⁰ MDC's claim that publishers of case reports traditionally star paginate to parallel sets of reports fails to note that publishers have traditionally star paginated to the *official reports*, not to unofficial reports of private publishers.

thus in harmony with the text of the 1976 Copyright Act and fundamental principles of copyright law established by this Court.

The copyright statute protects any expression original to the author once it is fixed in a tangible medium. 17 U.S.C. § 102. The definition of "literary works" makes clear that the *form* of an author's copyrightable expression is unlimited, provided it is both fixed and original. 17 U.S.C. § 101. It "does not connote any criterion of literary merit or qualitative value: it includes catalogs, directories and similar factual, reference or instructional works and compilations of data." H.R. Rep. No. 94-1476, 94th Cong., 2d Sess. 57, *reprinted in* 1976 U.S. Code Cong. & Ad. News 5659, 5667. As this Court recently noted, "[c]reation of a non-fiction work, even a compilation of pure fact, entails originality." *Harper & Row, Publishers, Inc., supra*, 105 S.Ct. at 2224. West's compilations — embracing its sequencing and pagination of case reports — are thus copyrightable "literary works" within the definition of the 1976 Copyright Act.

MDC's contention that West's "page numbers"¹¹ are uncopyrightable misapprehends the expression the court of appeals held was protected by copyright law. The letters of the alphabet or specific words, like page numbers, cannot be copyrighted. 17 U.S.C. § 102. But when an author combines numbers, letters or words in a manner that reflects an original work of authorship, they constitute copyrightable expression. *Id.* Thus, the issue is whether MDC is reproducing West's copyrightable expression — its original arrangements of case reports — not whether individual page numbers are copyrightable.

¹¹The terms of the injunction belie MDC's claim that the issue is the copyrightability of "page numbers". MDC is free to list West's page numbers *apart from* the text of the opinions. The injunction simply prohibits MDC from using West's page numbers "within or in relation to the text of court opinions contained in the LEXIS database." Modified Order for Preliminary Injunction (Pet. App. D at D2).

B. MDC's Star Pagination Infringes West's Copyrights.

Modern copyright law supports the court of appeals' conclusion that MDC's star pagination is likely to infringe West's copyrights. The statute reserves to West, the copyright owner, the exclusive right "to reproduce the copyrighted work in copies. . . ." 17 U.S.C. § 106(1). The statutory definition of a "copy" under the 1976 Copyright Act, 17 U.S.C. § 101, makes clear that the act of *inputting* a copyrighted work into a computer database, in and of itself, constitutes copyright infringement. M. Nimmer, 2 *Nimmer on Copyright* § 8.08 at 8-104 (1985); Final Report of the National Commission on New Technological Uses of Copyrighted Works at p. 12 (July 31, 1978).¹² The statute also explicitly reserves to West the right to display its copyrighted works publicly.¹³ 17 U.S.C. § 106(5).

The result of MDC's star pagination is a complete reproduction of West's ordering of its case reports. It is not, as MDC contends, mere "citation to" West's publications. It is not an isolated use of West's copyrighted compilations. It is the wholesale appropriation of every aspect of West's arrangements of case reports. It is " 'a major inroad on copyright that must be prevented.' " *Harper & Row, Publishers, Inc., supra*, 105 S.Ct. at 2235 (quoting S. Rep. No. 94-473, 94th Cong., 1st Sess. at 65 (1975)).

MDC's characterization of LEXIS as a "service" to the public which imparts "knowledge" does not change the nature of the infringement. "[A]ny copyright infringer may claim to benefit the public by increasing public access to

¹² The Commission's recommendations were accepted by Congress (See H.R. Rep. No. 96-1307 Part I 96th Cong. 2d Sess. 23 reprinted in 1980 U.S. Cong. & Ad. News 6460, 6482) resulting in enactment of the "Computer Software Copyright Act of 1980," Act of December 12, 1980, Pub. L. No. 96-517.

¹³ Unlike the principal defendants in *Sony Corp. of America, supra*, MDC is not being charged as a vicarious infringer by virtue of simply supplying a machine used by another for infringing purposes. Here, MDC is a direct infringer in two respects: (1) it has reproduced West's arrangements in a computer database; and (2) it intends to display West's arrangements from its copyrighted works publicly. 17 U.S.C. § 106(1) and (5).

the copyrighted work." *Harper & Row, Publishers, Inc.*, *supra*, 105 S.Ct. at 2235. Significantly, this case does not involve restrictions on access to judicial opinions or statutes themselves. The preliminary injunction does not prevent MDC from continuing to disseminate its LEXIS case reports as it has since 1973, or otherwise restrict MDC's display of judicial or legislative materials. Rather, the district court's order only prevents MDC from reproducing and displaying West's particular arrangements of case reports.¹⁴

Finally, the claim that the public importance of West's arrangements should result in reduction or elimination of the exclusive rights normally granted by copyright law was recently rejected by this Court. *Harper & Row, Publishers, Inc.*, *supra*, 105 S.Ct. at 2230. Rather, this Court reemphasized its holding in *Sony Corp. of America*, *supra*, that "every commercial use of copyrighted material is presumptively an unfair exploitation. . . ." *Harper & Row Publisher, Inc.*, *supra*, 105 S.Ct. at 2231 (citations omitted). Thus, the 1976 Copyright Act and recent decisions of this Court provide strong support for the court of appeals' conclusion that West has a substantial likelihood of succeeding on its copyright infringement claim.

III. Review By This Court Prior To Full Development Of The Factual Record Would Be Premature.

The court of appeals affirmed the district court's grant of a *preliminary* injunction. The court of appeals explicitly set forth the conditional nature of its decision. "[O]ur observations as to the governing law made in this opinion, are tentative and provisional, in the sense that *different findings or conclusions might be warranted after a trial on the merits.*" 799 F.2d at 1229 [Pet. App. A at A19] (emphasis added) (citations omitted).

¹⁴ The fact that MDC employed technological innovations to infringe West's copyrights does not justify the infringement. Courts have always been quick to proscribe new ways of infringing copyrights. See *Columbia Pictures Industries, Inc. v. Aveco, Inc.*, 800 F.2d 59 (3d Cir. 1986).

Numerous facts which may be critical to the outcome were not developed prior to the district court's order. These facts relate to such matters as the method by which West gathers, edits, assigns and sequences its case reports, and the method by which MDC intends to reproduce and display West's arrangements in its database.¹⁵ No documents were produced by either side prior to the district court hearing, nor were any depositions taken. Because a final judgment has not been entered, this case "is not yet ripe for review by this Court." *Brotherhood of Locomotive Firemen & Enginemen v. Bangor & Aroostook Railroad Co.*, 389 U.S. 327, 328 (1967).

Further, West's Complaint alleges additional causes of action under Section 43(a) of the Lanham Act, 15 U.S.C. § 1125(a); the Minnesota Deceptive Trade Practices Act, *Minn. Stat.* § 325D.44; the Minnesota Unlawful Trade Practices Act, *Minn. Stat.* § 325D.13; and the common law of misappropriation and unfair competition. West limited its preliminary injunction motion, however, to the copyright infringement claim of its Complaint. Thus, the court of appeals rendered no opinion, tentative or otherwise, on the remaining ten counts of the Complaint. The issues presented by MDC's petition may well become moot after a full trial on all counts of the Complaint. In any event, a trial on the merits will generate a complete record upon which the lower courts, and possibly this Court, may make final determinations on the controlling legal issues.

IV. The Issues Raised By MDC's Petition Do Not Merit This Court's Attention.

Not surprisingly, no decision addressing the issue of star pagination of judicial opinions was reported between the *Banks* decision in 1909 and the district court's decision

¹⁵ For example, on appeal to the court below MDC consistently denied that its star pagination would permit a LEXIS user to retrieve, display or print cases in the sequence or order in which West arranges them in volumes. Brief for Appellant at p. 38-39; Reply Brief for Appellant at pp. 12 n.8, 17. Yet, at oral argument, MDC conceded its star pagination *would* permit the LEXIS user to page through each case and successive cases utilizing West's sequencing. 799 F.2d at 1227 [Pet. App. A at A14].

below in 1985. The reason is not difficult to discern. The issues raised by MDC's petition affect a minute segment of society — private publishers of case reports. Unlike MDC, those private publishers such as Commerce Clearing House, Lawyers Co-Operative Publishing Company, Prentice-Hall, the Bureau of National Affairs, Callaghan & Company and others have developed and utilized their own arrangements of case reports.

One of the considerations established by this Court governing review on certiorari is whether "a federal court of appeals has decided an important question of federal law which has not been, but should be, settled by this Court..." Sup. Ct. R. 17.1(c). Importance is measured by the impact of the decision on the public "as distinguished from that of the parties." *Rice v. Sioux City Memorial Park Cemetery*, 349 U.S. 70, 79 (1955). This Court has stated:

A federal question raised by a petitioner may be 'of substance' in the sense that, abstractly considered, it may present an intellectually interesting and solid problem. But this Court does not sit to satisfy a scholarly interest in such issues. Nor does it sit for the benefit of the particular litigants.

Id. at 74.

While the issues presented by MDC's petition are significant to the parties and possibly interesting to lawyers, the outcome has virtually no impact on non-parties or the public at large. Moreover, MDC's claimed success with its LEXIS service over the last 13 years demonstrates its ability to offer an electronic, competitive alternative to traditional hard copy publications. Review by this Court of the interlocutory decision of the court of appeals is thus unwarranted.

CONCLUSION

Based on the foregoing, the petition for a writ of certiorari should be denied.

Respectfully submitted,

VANCE K. OPPERMAN
JOSEPH R. KERNAN, JR.
DIANE M. HELLAND

*Counsel for Respondent
West Publishing Company*

OPPERMAN & PAQUIN
2200 Washington Square
100 Washington Avenue South
Minneapolis, Minnesota 55401
(612) 339-6900

December 31, 1986